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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,314	09/28/2001	Matthew H. Bernius	83530PCW	5043

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EXAMINER	
RIES, LAURIE ANNE	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/966,314	BERNIUS ET AL.	
	Examiner	Art Unit	
	Laurie Ries	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

- Preliminary amendment received on 6/14/2002 includes the addition of a paragraph: Cross-Reference to Related Applications. Only one page of this amendment was received, and the paragraph is incomplete. The last line listed on the copy of the amendment referenced during examination is: "...Automatically Modified Links In An HTML Page Sequence Upon Insertion Of..."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially real-time" in claim 9 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite

degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 1-9, the language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before

> the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Roy (U.S. Publication 2003/0069897 A1).

As per claim 1, Roy discloses a discussion board of a website having images associated with a portion of the text, which includes a discussion portion having text inserted by users of the discussion board (See Roy, Figure 5, elements 502 and 506), a text-insert section which inserts written text into the discussion portion for discussing one or more subjects (See Roy, Page 5, paragraph 0040, and Figure 5, element 502), and a webpage which automatically inserts either a predetermined or an uploaded image into the discussion portion upon command for enhancing the text upon request (See Roy, Figure 5, and Page 3, paragraphs 0023, 0025, and 0028).

As per claim 2, Roy discloses a link to a webpage (See Roy, Page 1, paragraph 0009, and Page 3, paragraph 0024).

As per claim 3, Roy discloses that the webpage includes a number of pre-determined images for selection (See Roy, Page 3, paragraph 0024).

As per claim 5, Roy discloses a method for using a discussion board including retrieving the discussion board from the Internet (See Roy, Figure 5, and Page 1, paragraph 0009), inserting text into a discussion portion of the discussion board for discussing one or more subjects (See Roy, Page 5, paragraph 0040, and Figure 5, element 502), and automatically inserting images

into the discussion board upon command for providing enhancement to the text (See Roy, Figure 5, and Page 3, paragraphs 0023, 0025 and 0028).

As per claim 6, Roy discloses activating a link to a webpage which uploads an image for insertion into the discussion board, or contains pre-determined images for insertion into the discussion board (See Roy, Page 1, paragraph 0009, and Page 3, paragraph 0024).

As per claim 7, Roy discloses selecting at least one image from a number of pre-determined images for insertion into the discussion board (See Roy, Page 3, paragraph 0023).

Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Miyazawa (U.S. Publication 2001/0018703 A1).

As per claim 9, Miyazawa discloses a discussion board of a website having images associated with a portion of the text, which includes a first set of text input on-line on a substantially real-time basis having an image positioned adjacent the first text (See Miyazawa, Figure 17, and Page 3, paragraph 0046), and which also includes a second set of text input on-line on a substantially real-time basis having a corresponding image positioned adjacent the second text (See Miyazawa, Figure 17, and Page 3, paragraph 0046).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (U.S. Publication 2003/0069897 A1) as applied to claims 1 and 5 above, and further in view of Takahashi (U.S. Publication 2002/0166050 A1).

As per claims 4 and 8, Roy discloses the limitations of claims 1 and 5 as described above. Roy does not disclose expressly that the webpage includes verification of copyright ownership of the downloaded images. Takahashi discloses verifying copyright information. Roy and Takahashi are analogous art because they are from the same field of endeavor of processing image data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the copyright verification of Takahashi with the website discussion board including a downloaded image of Roy. The motivation for doing so would have been to protect digital image data copyright. (See Takahashi, Page 1, paragraph 0006). Therefore, it would have been obvious to combine Takahashi with Roy for the benefit of protecting the copyright of a digital image to obtain the invention as specified in claims 4 and 8.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Olivier (U.S. Patent 6,480,885 B1) discloses a method for enabling users to exchange individual profiles and criteria, for determining personalized subsets within a group.
- Fiechter (U.S. Patent 6,743,102 B1) discloses an interactive electronic game system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is currently (703) 605-1238. After mid-October, 2004, the examiner can be reached at (571) 272-4095. The examiner can normally be reached on Monday-Friday from 7:00am to 3:30pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LAR

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER